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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,338	11/06/2001	Thanh V. Lam	POU901015US1	6039

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EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,338

Applicant(s)

LAM ET AL.

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/02/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 11-29, 41-62 and 64-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 30-40 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/8/01</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-66 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Taken as a whole the claims recite an undue multiplicity of claims by virtue of the unreasonable number of claims presented would tend to obfuscate, confuse, and becloud the claimed invention. Because the examiner believes that in his judgment that twenty-five (20) claims are sufficient to properly define applicants' invention, applicants are required to select certain claims, not to exceed twenty for examination on the merits of which no more than six are independent claims, See M.P.E.P. 2173.05(n). Note applicants have 17 independent claims and the office has held that more than six independent claims (4.9% of cases filed) in an application is unreasonable (See Federal register below). To be complete **the non-selected claims must be cancelled** or the applicant(s) must present appropriate arguments as to why the above rejection is in error. Note most patents (80%) have less than twenty claims while patents in excess of 65 claims are less than one per cent of all cases filed and thus rare (See Federal Register: October 5, 1998 (Volume 63, Number 192, Page 53507). Note also the new excess claim fees effective 12/8/04 as evidence of what is considered to be unreasonable.

The rejection under this paragraph is made final. Examiner agrees with applicants that a multiplicity of inventions are

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present. Specifically, four claim sets are presented. These sets are as follows:

Set 1: Claim 1-10, 30-40 & 63;

Set 11: Claims 1 1-17, 41-48 & 64;

Set 111: Claims 18-29, 49-58 & 65; and

Set IV: Claims 27-29, 59-62 & 66.

Claims 11-29, 41-62, 64-66 stand withdrawn from further consideration and should be deleted. The restriction grouping suggested by applicant is proper and the applicants are free to file divisional applications thereon if they so choose.

Applicants arguments dated 05/02/2005 are unpersuasive.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-10, 30-40 & 63 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts;
and

(2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1, 30, 40, or 63 only recites an abstract idea. The recited steps of merely obtaining information about a job in a queue does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to obtaining information about a job in a queue.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces job information (i.e., repeatable) used in a display (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is

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deemed to be directed to non-statutory subject matter.

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claims 1-10, 30-40 & 63 are rejected under 35 U.S.C. § 103 as being unpatentable over Silva et al (6014760) in view of Freund (6076174).

Regarding claim 1, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose method for testing process jobs by collecting packet information thereon substantially as claimed. The differences between the above and the claimed invention is the use of specific terminology. It is noted that it is believed that the job packets are functionally equivalent to the claimed limitations. Freund(See Fig. 2, Col. 3, lines 25-40, col. 4,

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lines 25-50) show performance characteristics of a job in real time . It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Silva et al because it is standard practice to monitor performance characteristics. Regarding the tracked limitations of claim 2, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose testing process jobs by collecting packet information thereon which is a functional equivalent of the claim limitations. Regarding the list limitations of claim 3, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose testing process jobs by collecting packet information thereon which is a functional equivalent of the claim limitations because performance measures require predefined rating levels. Regarding the limitations of claims 4-10, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose testing process jobs by collecting packet information thereon describing performance characteristics which is a functional equivalent of the claim limitations. Regarding claim 30, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose means for testing process jobs by collecting packet information thereon substantially as claimed. The differences between the above and the claimed invention is the use of specific terminology. It is noted that it is believed

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that the job packets are functionally equivalent to the claimed limitations. Freund (See Fig. 2, Col. 3, lines 25-40, col. 4, lines 25-50) show performance characteristics of a job in real time. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Silva et al because it is standard practice to monitor performance characteristics. Regarding the tracked limitations of claim 31, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose testing process jobs by collecting packet information thereon which is a functional equivalent of the claim limitations. Regarding the list limitations of claim 32, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose testing process jobs by collecting packet information thereon which is a functional equivalent of the claim limitations because performance measures require predefined rating levels. Regarding the limitations of claims 33-39, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose testing process jobs by collecting packet information thereon describing performance characteristics which is a functional equivalent of the claim limitations. Regarding claim 40, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose means for testing process jobs by collecting packet information thereon substantially as claimed.

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The differences between the above and the claimed invention is the use of specific terminology. It is noted that it is believed that the job packets are functionally equivalent to the claimed limitations. Freund(See Fig. 2, Col. 3, lines 25-40, col. 4, lines 25-50) show performance characteristics of a job in real time . It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Silva et al because it is standard practice to monitor performance characteristics. Regarding claim 63, Silva et al (See abstract, Figs. 1 3, 4, Col. 5, lines 15-50, Col. 7, lines 25-55, Col. 10, lines 60-65) disclose method including computer readable media for testing process jobs by collecting packet information thereon substantially as claimed. The differences between the above and the claimed invention is the use of specific terminology. It is noted that it is believed that the job packets are functionally equivalent to the claimed limitations. Freund(See Fig. 2, Col. 3, lines 25-40, col. 4, lines 25-50) show performance characteristics of a job in real time . It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Silva et al because it is standard practice to monitor performance characteristics.

Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the

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specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

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Alexandria, VA 22313-1450

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PRIMARY EXAMINER
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